



BD 7 Appeals

Practitioner's Docket

U 013698-2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kazuaki WATANABE, et al

Application No. 10/001,256

Group No.: 1755

Appeal No. 2005-1629

Filed: November 2, 2001

Examiner: Callie E. Shosho

For: INK COMPOSITION FOR INK JET PRINTER

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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TRANSMITTAL

WARNING: Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).

1. Transmitted herewith is an amendment for this application.

STATUS

2. The application is qualified as
☐ a small entity.
☒ other than a small entity.

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CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. §1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

NOTE: 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

	<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input type="checkbox"/>	one month	\$ 120.00	\$ 60.00
<input type="checkbox"/>	two months	\$ 450.00	\$ 225.00
<input type="checkbox"/>	three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/>	four months	\$ 1,590.00	\$ 795.00
<input type="checkbox"/>	five months	\$ 2,160.00	\$ 1,080.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)		SMALL ENTITY	OTHER THAN A SMALL ENTITY	
Claims Remaining After Amendment		Highest No. Previously Paid For		Present Extra		Addit. Fee Rate	O R	Addit. Fee Rate
Total	*	Minus	**	=	x \$ 25	\$		x \$ 50= \$
Indep.	*	Minus	***	=	x \$ 100	\$		x \$ 200 \$
<input type="checkbox"/> First Presentation of Multiple Dependent Claims						+ \$180= \$		+ \$360= \$
Total						Addit. Fee	\$ ____ O R	Total Addit. Fee \$ ____

- * If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,
** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☒ No additional fee for claims is required.

OR

- (d) ☐ Total additional fee for claims required \$ _____

FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ _____
☐ Charge Account No. 12-0425 the sum of \$ _____
A duplicate of this transmittal is attached.

FEE DEFICIENCY OR OVERPAYMENT

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 12-0425

AND/OR

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CLIFFORD J. MASS

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PATENT

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SUPPLEMENTAL REPLY BRIEF

This brief is in reply to the supplemental Examiner's Answer mailed 19 May 2005.

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"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

With respect to issue I(A) of the Reply Brief, Appellants had argued that whether **the Appellants' claims** are open to the inclusion of alginate is irrelevant to a specific issue raised by the Examiner (whether one of skill in the art would have had a motivation to combine the penetrating agents of Sano et al with inks, such as those described in the primary reference, which do not include an alginate). The supplemental Examiner's Answer respectfully sidesteps that specific issue and re-argues the issue of whether the references do in fact provide a motivation for their combination. Appellants address the re-argued issues below, but respectfully note that the arguments on these issues do not relate to whether or not the Appellants' claims are open to the inclusion of alginate.

With respect to issue I(B) of the Reply Brief, the Examiner respectfully pigeonholes Appellants' argument with respect to the (lack of) motivation provided by Sano et al as revolving exclusively around the question of color bleed. The argument, as stated most fully in Appellant's Brief filed September 10, 2004, is that Sano et al teach the importance of (a) **reducing** the penetration of ink into a recording medium in many circumstances to enhance coloring properties ("In general, in order to enhance the coloring properties, it is preferred to inhibit the penetration of the ink." Sano et al at column 1, lines 62-64); and (b) maintaining a **balance** between the enhancement of coloring properties and the inhibiting of color bleeding (Appellant's Brief at page 12). The argument in the Reply Brief is that there is nothing in the prior art to suggest that greater (or lesser) penetration, as presumably would be achieved by replacing the JP 11217525 penetrating agents with the recited penetrating agent, would have been necessary or desirable in the JP 11217525 compositions.

The Examiner argues with respect to issue I(B) in the supplemental Examiner's Answer "that Sano et al teach that the use of penetrating agent not only provides reduced color bleed but also produces images with improved image quality and enhanced color properties". The Examiner is respectfully in error when she ascribes the improvements described in Sano et al to the use of the penetrating agent alone. Sano et al make clear that the desired balance in properties is achieved by providing an ink composition that also contains an alginate that can prevent the ink composition from penetrating into the recording medium so as to eliminate color bleeding while improving coloring properties (see Sano et al at paragraph bridging columns 5 and 6). There would have been no motivation to use the Sano et al penetrating agent in an ink composition of another reference that does not comprise an alginate for balancing of the properties, especially where as here the other reference (JP 11217525) already purports to achieve a desired balance.

With respect to issue I(C), Appellants agree with the Examiner that the issue is not whether Sano et al teach the desirability of the comparative ink compositions. (The Examiner would appear to agree that the Comparative Examples are less desirable than the Examples.) The issue is whether the Comparative Examples would suggest the desirability of using the claimed penetrating agent in the ink compositions of the primary references when Sano et al teach that the alginate is needed for a proper balance of properties in the Sano et al ink compositions (see discussion above).

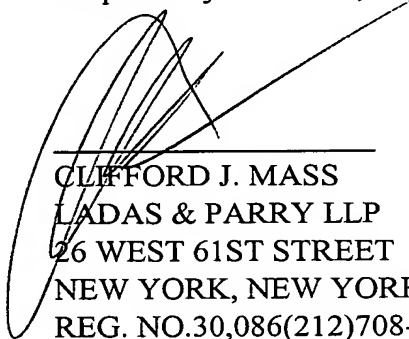
With respect to issue II(A) of the Reply Brief, the Examiner respectfully is misconstruing

the Sano et al reference in arguing that the reference teaches that the penetrating agent produces the “necessary” penetrating capacity for compositions other than the Sano et al composition. Sano et al make clear that the desired penetration of the inks described therein is achieved by a balance also involving at least the alginate (Sano et al at paragraph bridging columns 5 and 6). Thus, while the penetrating agent described in Sano et al may be useful for the ink compositions described therein, there is nothing in Sano et al that would show or suggest that the same amount of penetration would be desirable in an ink not including the alginate. Indeed, one of skill in the art would understand from Sano et al that a balance must be achieved by matching the penetrating agent with other components in an ink composition. The balance of properties in a particular ink composition might thus require less (or greater) penetration than in the Sano et al compositions (depending on the components of such composition). The Examiner’s contention- - that Sano et al teach the criticality of the recited penetrating agent for providing the “necessary” penetrating capacity in all compositions- -is respectfully not in accord with the reference teachings.

With respect to issue II(C) of the Reply Brief, the Examiner’s argument respectfully shows that she has not given sufficient weight to the evidence of unexpected results of record in this application. The Examiner’s position is that there is a motivation to combine the references and that the resultant combination would **intrinsically** have the unexpected properties shown in the rebuttal evidence of record. This analysis respectfully falls short of the requirement that all evidence on the question of obviousness must be considered and weighed, both that supporting and that rebutting the *prima facie* case (see, e.g., *Richardson-Vicks Inc. v. Upjohn Co.*, 44

USPQ2d 1181,1186 (Fed. Cir. 1997)). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a *prima facie* case was reached (see, e.g., *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990)). It is respectfully submitted that the Examiner has not done this- -she has not weighed the evidence of unexpected results against the factors giving rise to the alleged *prima facie* case of obviousness. Rather, the Examiner has, respectfully, improperly relied solely upon an inherency rationale, i.e. that the unexpected properties would inherently be present in a combination of the references. The rejections should respectfully be overturned for this reason alone.

Respectfully submitted,



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